

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCE

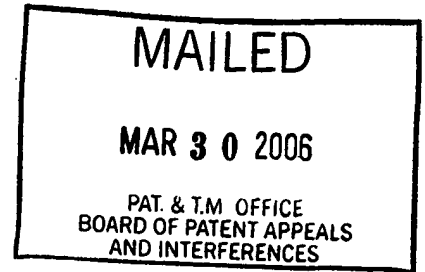
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Ex parte SATORU MOTOYAMA

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Application 09/037,822

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was electronically received at the Board of Patent Appeals and Interferences (BPAI) on March 14, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matter requiring attention prior to docketing are identified below.

On December 11, 2001, appellants filed an Information Disclosure Statement (IDS). It is not clear from the record whether the examiner considered the IDS or whether the examiner notified appellants of why their submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98.

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On November 16, 2005, an Examiner's Answer was mailed. A review of the Examiner's Answer reveals that it is not in compliance with the headings as required under 37 CFR § 41.37(c).

An in-depth review of the Examiner's Answer mailed November 16, 2005, reveals that under the heading "Evidence Relied Upon," the prior art relied on was not listed. The MPEP 1207.02(A) states:

A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

- (8) *Evidence Relied Upon.* A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

Proper correction of the Examiner's Answer is required.

Accordingly, it is ORDERED that the application is return to the Examiner to:

- 1) consider the Information Disclosure Statement filed December 11, 2001;
- 2) provide appropriate written notification by the examiner to appellants of such consideration;
- 3) to have a copy of the consideration of the Information Disclosure Statement scanned into the record; and

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- 4) to vacate the Examiner's Answer mailed November 16, 2005, and issue a revised Examiner's Answer in accordance with the new rules; and
- 5) for such further action as may be appropriate.

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A handwritten signature in black ink, appearing to read 'D. M. Shaw', written over a horizontal line.

DALE M. SHAW  
Program and Resource Administrator  
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DMS/pgc

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